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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,352	03/23/2004	Thomas M. Rent	02708.0033.CNUS01	3993
22930	7590	01/07/2005	EXAMINER	
HOWREY SIMON ARNOLD & WHITE LLP c/o IP DOCKETING DEPARTMENT 2941 FAIRVIEW PARK DR, SUITE 200 FALLS CHURCH, VA 22042-2924			CHANG, YEAN HSI	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,352

Applicant(s)

RENT, THOMAS M.

Examiner

Yean-Hsi Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 9 is objected to because of the following informalities: There may be a word missing in line 3. Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,621,821 B1 ('821). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 10 is identical with portion of claim 1 of '821.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Santeler et al. (US 5,986,880).

Santeler teaches an electronic data storage apparatus (12, fig. 1) for use in connection with an electronic data processing device (10), comprising: a plurality of substrate (14) adapted for insertion into a chassis (12), at least one electronic data storage device (20), said at least one electronic data storage device mounted on said substrate (fig. 1), electrical circuitry (36) operably associated with said substrate and said at least one electronic data storage device, and means (32) for electrically connecting said electrical circuitry with said data processing device (claims 1, 8 and 10); wherein said substrate comprises a printed circuit card (see col. 3, lines 27-32) (claim 2); wherein said at least one electronic data storage device comprises a hard disk drive (see col. 3, lines 35-38) (claim 3); wherein said means for electrically connecting said electrical circuitry with said data processing device comprises a multi-pin electrical connector (see fig. 2) (claim 5); and a controller (30) for controlling transfer of data to

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and from said at least one electronic data storage device and said data processing device (see col. 4, lines 40-55) (claims 6-8).

6. Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Fleming (US 6,073,188).

Fleming teaches an electronic data processing apparatus (fig. 1A) comprising: at least one processing unit (C), at least one data storage apparatus (202) comprising at least one data storage device (202), at least one controller (102) for controlling the transfer of data to and from said at least one data storage device and for controlling the transfer of data to and from said at least one processing unit (see col. 5, lines 42-48; col. 6, lines 21-29; and col. 7, lines 9-16), and a switch (220) for directing data from at least one of said processors to at least one of said data storage devices and for directing data from at least one of said data storage devices to at least one of said processors (see fig. 3).

7. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsukada et al. (US 5,481,432).

Tsukada teaches an electronic data storage apparatus (fig. 13) for use in connection with an electronic data processing device (55), comprising: a substrate (340), at least one electronic data storage device (a flash memory device 60), said at least one electronic data storage device mounted on said substrate (fig. 16), electrical circuitry (58) operably associated with said substrate and said at least one electronic

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data storage device, and means (bus shown in fig. 13, not labeled) for electrically connecting said electrical circuitry with said data processing device.

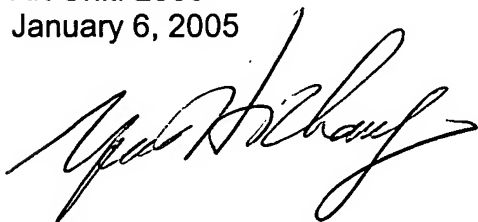
Correspondence

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yean-Hsi Chang whose telephone number is (571) 272-2038. The examiner can normally be reached on 07:30 - 16:00.

If attempts to reach the examiner by telephone are unsuccessful, the Art Unit phone number is (571) 272-2800, ext. 35. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3431 for regular communications and for After Final communications. There are RightFax numbers and provide the fax sender with an auto-reply fax verifying receipt by the USPTO: Before-Final (703-872-9318) and After-Final (703-872-9319).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8558.

Yean-Hsi Chang
Primary Examiner
Art Unit: 2835
January 6, 2005

A handwritten signature in black ink, appearing to read 'Yean-Hsi Chang', is written over the typed name and date.